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10/563,081	04/21/2008	Werner Scholtyssek	SCHOLTYSSEK	8109

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EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1796

NOTIFICATION DATE	DELIVERY MODE
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02/23/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 10/563,081	Applicant(s) SCHOLTYSSEK ET AL.	
	Examiner MARIE REDDICK	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/25/09 & 12/01/09.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-27 is/are rejected.
- 7) ☒ Claim(s) 15 and 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/01/09</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 12/01/09 has been considered by the Examiner. Applicant is herein apprised that the date is missing for the item no. 4 document under "OTHER DOCUMENTS".

Claim Objections

2. Claims 15 and 26 are objected to because of the following informalities: i) in claim 1 @ line 1, it is **suggested** that the definite article "the" be inserted between "in" and "form"; ii) in claim 26 @ lines 4 & 9, it is **suggested** that "watery" be deleted and "aqueous" inserted in its stead, consistent with the amendment to claim 15.. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 15-27 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for i) a dispersoid of a polymer derived from ethylenically unsaturated monomers which include olefins such as ethylene, propylene, and isobutylene, halogenated olefins such as vinyl chloride and vinyl fluoride, (meth)acrylic acid esters such as methyl methacrylate, methyl acrylate, ethylacrylate, etc., (meth)acrylic acids, dimethyl aminoethyl acrylate and quaternary compounds thereof, acrylamide monomers, styrol monomers, N-vinylpyrrolidone, diene monomers such as butadiene, isoprene and chloroprene, vinyl ester monomers such as vinyl acetate, vinyl propionate and vinyl versatate; ii) a first dispersing agent which is a hydrolysed vinyl ester-ethylene copolymer wherein the vinyl ester includes

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vinyl formiate, vinyl acetate, vinyl propionate and vinyl pivalate and iii) a further dispersing agent which includes polyvinyl alcohol does not reasonably provide enablement for i) a dispersoid of a polymer of an ethylenic unsaturated monomer, ii) a first dispersing agent from a polyvinyl alcohol modified by ethylene units and iii) a further dispersing agent which is a vinyl alcohol polymer. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. The invention as described in the specification is drawn to a polyvinyl acetate adhesive of improved properties relative to water stability and heat resistance. Because it is believed that the nature of the ingredients would affect such, it is doubted that all would be operable or that given the present specification, one could determine, without undue experimentation, which are or are not operable falling within the broad scope of the claims.

Claim Rejections - 35 USC § 102/103

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 15, 16, 18-25 & 27 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Tanimoto et al (JP 2000230098).

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Tanimoto et al teach aqueous emulsion compositions excellent in viscosity stability and water-resistant adhesiveness, useful as woodwork & plywood adhesives, and defined basically as containing A) an amino-containing water-based resin, B) an aqueous emulsion comprising i) a dispersoid and ii) dispersants wherein the dispersoid is a polymer having units derived from ethylenically unsaturated monomers which include vinyl acetate, ethylene, etc. and diene monomers such as butadiene, preferably the dispersoid is polyvinyl acetate and the dispersant is a vinyl alcohol polymer having a degree of saponification of at least 95 mol % and/or a polyvinyl alcohol polymer containing 1-15 mol % of ethylene units in the molecule and having a degree of saponification of at least 95 mol % and a degree of polymerization of 100-7000 and C) other conventional additives such as organic solvents, starches, water-soluble polymers such as polyvinyl alcohol, etc. (Abstract, paragraphs [0001]-[0008], [0010]-[0012] and [0025] of Tanimoto et al and claims 15, 16, 19-21, 23, 24 & 27). Tanimoto et al further teach that the dispersant ii) is used in an amount of 3-20 wt. % and that the ratio of amino-containing water-based resin (A) to aqueous emulsion (B) is 99.9/0.1 to 50/50 (paragraphs [0009] & [0024] of Tanimoto et al and claims 18, 22 & 25).

Tanimoto et al therefore anticipate the instantly claimed invention.

As to the pH limitation (claim 15), although silent, it is reasonable that the aqueous emulsion system of Tanimoto et al may very well meet the pH limitation since the aqueous emulsion system of Tanimoto et al is essentially the same as and made under essentially the same conditions as the claimed aqueous dispersion system, in the absence of the USPTO to have at its disposal the tools and/or facilities deemed necessary to make physical determinations of this sort. The burden to show that this, in

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fact, is not the case, is shifted to applicants. Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. Even if it turns out that the Examiner has somehow missed the boat and the claims are not anticipated, it would have been obvious to the skilled artisan, at the time the invention was made, to extrapolate, from Tanimoto et al, the precisely defined adhesive as per such having been within the purview of the general disclosure of Tanimoto et al and with a reasonable expectation of success.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tanimoto et al (JP 2000230098).

Tanimoto et al is as discussed supra and as applied to claims 15, 16, 18-25 & 27. Further, Tanimoto et al differs basically from the claimed invention as per the non-express disclosure of an embodiment directed to the adhesive of claim 16, wherein the polyvinyl acetate has a degree of polymerization of from 100 to 2500 (claim 17). However, the polyvinyl acetate component (dispersoid) of Tanimoto et al is generic too and, as such, necessarily implies that any polyvinyl acetate, including the claimed polyvinyl acetate, would have been operable within the scope of patentees' invention and with a reasonable expectation of success, absent some evidence of unusual or unexpected results.

Claim Rejections - 35 USC § 103

12. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tanimoto et al (JP 2000230098) in combination with Eck et al (US 4,528,315).

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Tanimoto et al is as discussed supra and as applied to claims 15-25 & 27. Further, Tanimoto et al differs basically from the claimed invention as per the non-express disclosure of an embodiment directed to the adhesive of claim 15, wherein the vinyl alcohol polymer comprises a first partially saponified polymer with a polymerization degree of from 1500 to 3000, a degree of hydrolysis from 88 to 92 Mol % and a viscosity from 15 to 30 mPa. sec., each in watery solution, in an amount of from 0.1 to 1.50 % by weight, relative to the dispersion, and a further partially saponified polymer with a polymerization-and hydrolysis degree like the first partially saponified polymer and having a viscosity from 30 to 50 mPa. sec, each in a 4 % watery solution, in an amount from 0.5 to 1.5 % by weight, relative to the dispersion (claim 26).

Eck et al teach a process for the preparation of aqueous dispersions stabilized by protective colloid(s) suitable as adhesives, also emulsion (co)polymerization of vinyl halides and/or vinyl esters and, if needed, additional monomers wherein the emulsion (co)polymerization is carried out in the presence of at least one polyvinyl alcohol (PVAL) governed by a degree of hydrolysis of 70 to 99.8 mol. % and a degree of polymerization of 200 to 3,000, as a first dispersing agent (the Abstract, col. 1, lines 6-13, 29-36 & 53-68 & col. 2, lines 1-8 of Eck et al). Eck et al further teach for the use in the building sector as an adhesive, the use of protective colloids, during polymerization, is suggested and includes ***at least one*** polyvinyl alcohol with a degree of hydrolysis of 70 to 99.8 mol. %, preferably from 74 to 99.5 mol. %, a degree of polymerization of from 200 to 3,000 and a viscosity of from about 3 to about 50 m.Pas of a 4 % by weight aqueous solution at 20 degree C, added in amounts of 0.5 to 15 wt. %, preferably, 3 to 10 wt. %, calculated with respect to the monomers that are liquid

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under reaction conditions (the paragraph bridging cols. 3 & 4 and col. 4, lines 8-23 of Eck et al and claim 26). Eck et al further teach, operable within the scope of the invention, the use of mixtures of various different protective colloids (col. 4, lines 28-37 of Eck et al and claim 26).

Therefore, one having ordinary skill in the art, following the aforementioned guidelines of Eck et al, would have found it obvious, at the time the invention was made, to modify Tanimoto et al by optimizing the aqueous emulsion system using a mixture of partially saponified polymers as suggested by Eck et al in the aqueous emulsion system of Tanimoto et al and with a reasonable expectation of enhancing the stability of the aqueous emulsion system of Tanimoto et al, such involving only routine experimentation and with a reasonable expectation of success. Criticality for such, clearly commensurate in scope with the claims, not having been demonstrated on this record.

Response to Arguments

13. Applicant's arguments filed 11/25/09 have been fully considered but they are not persuasive.

Relative to the Rejection of claims 15-27 under 35 USC 112, first paragraph.....

It is urged that the rejection is deemed proper, herein maintained as per reasons of record. The invention, as described in the specification, is drawn to a polyvinyl acetate adhesive of improved properties relative to water stability and heat resistance. Because it is believed that the nature of the ingredients would affect such, it is doubted that all would be operable or that given the present specification, one could determine, without undue experimentation, which are or are not operable falling within the broad scope of the claims.

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Relative to the Rejection of Claims 15, 16, 18-25 & 27 under 35 U\$C 102

(b)/103(a) as obvious over Tanimoto et al (JP 2000230098), the Rejection of claim 17 under 35 U\$C 103 (a) over Tanimoto et al (JP 2000230098) and the Rejection of claim 26 under 35 U\$C 103 (a) over Tanimoto et al (JP 2000230098) in combination with Eck et al (U\$ 4,528,315).....It is urged that the aforementioned

Rejections are deemed proper and are herein maintained as per reasons clearly stated in the Grounds of Rejection of Record (05/27/09). The **crux** of Counsel's arguments appears to hinge on i) the Abstract exceeds the disclosure of the specification and is thus not considered prior art and ii) claims 15, 16, 19-21, 23, 24 and 26, pointed out in Tanimoto by the Examiner is confusing since the reference did not show any claims at all.

It is with all due respect to Counsel's opinion, the Abstract of the Disclosure is a part of the prior art and is properly used for making the rejection based on Tanimoto. Counsel is herein reminded that a reference is evaluated, as a whole, for what it fairly teaches and is in no way limited to bits and pieces. Clearly the abstract teaches a combination of dispersants. There is absolutely nothing viable on this record diffusing this issue. Moreover, Tanimoto, throughout the disclosure, refers to a vinyl alcohol polymer **system** which clearly translates to more than one dispersant (at least paragraphs [0007], [0011] & [0032]).

As to the claims pointed out by the Examiner, the claims recited are referring to the instantly claimed invention. Counsel is cordially directed to the Rejections made in the previous Office Action (05/07/09), paragraphs 12, 16 & 17, in each case, Tanimoto precedes the recited claims which is a clear indication that the recited claims are not being relied on for the teachings of Tanimoto.

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As to the silence of a pH value in Tanimoto, there is nothing viable on this record rebutting the Examiner's reasonable presumption of the pH value of Tanimoto meeting the claimed pH value.

As to the combination of Tanimoto and Eck used in rejecting claim 26, it is urged and maintained that this rejection is proper. COMBINING EQUIVALENTS KNOWN FOR THE SAME PURPOSE : "It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art." In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARIE REDDICK whose telephone number is 2-5816. The examiner can normally be reached on 6:30 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, DAVID WU can be reached on 2-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/MR/
02/16/10

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